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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,045	07/13/2005	Hendrik Wermter	PP15-22821/ACGM 520/PCT	8680
324	7590	12/11/2009	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			NERANGIS, VICKIE MARIE	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			12/11/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/542,045

**Applicant(s)**

WERMTER ET AL.

**Examiner**

Vickey Nerangis

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Please note that the examiner of record has changed. The new examiner is Vickey Nerangis.
2. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 9/8/2009.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. A new grounds of rejection are necessitated below due to the amendment which includes an improper Markush group and has an incorrect formula (Id). Thus, the following action is properly made final.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities:
  - in part (d), the alternative expression is in improper alternative form. When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper (emphasis added). See MPEP § 2173.05(h).
  - the formula of (Id) has a dash at the front of the formula is a mistake given that it cannot represent a bond. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. Claims 1, 2, 4-8, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fumitoshi (JP 05-271481, correction) in view of Ton-That (US 7,220,484).

The rejection is adequately set forth in paragraph 2 of Office action mailed on 11/19/2008 and is incorporated here by reference.

***Response to Arguments***

7. Applicant's arguments filed 9/8/2009 have been fully considered but they are not persuasive. Specifically, applicant argues that it would not have been *prima facie* obvious to add nanoclay to Fumitoshi in view of unexpected results exhibited in specification as originally filed and Rule 132 Declaration by Dr. Rainer Xalter.

The data has been fully considered however it fails to established unexpected results because (i) the data is not a comparison to the closest prior art and (ii) the data is not reasonably commensurate in scope with the scope of the claims.

With respect to (i), the data in the specification shows improved yellowness index and oven aging when Irganofox 168 and/or Irganox 1010 and bisphenol A diglycidyl ether; however, this is not a comparison to the closest prior art given that Fumitoshi teaches the combination of claimed antioxidants and/or stabilizers and bisphenol A diglycidyl ether that provide for excellent thermal stability and excellent hue (paragraph 0001).

The data in the declaration shows an improvement in OIT (oxidation induction time which is indicative of polymer stability) when an organically modified nanoclay is used in polypropylene composition over unmodified microclay; however, this is not a comparison to the

closest prior art given that Ton-That teaches that intercalants are used to intercalate clay in order to provide for nanocomposites. While Fumitoshi does not teach intercalated inorganic fillers, such teachings are provided by Ton-That which teaches that clay nanocomposites and all of its advantageous properties such as thermal stability (col. 1, line 30) are had by adding a clay treated with ammonium and phosphonium intercalates to polypolefin (col. 5, lines 36-45). Case law holds that comparative showings must compare the claimed subject matter with the closest prior art to be effective. See *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979).

With respect to (ii), the data in both the specification and in the declaration are not reasonably commensurate in scope with the scope of the claims. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Specifically, the exemplified polypropylene is not reasonably commensurate with claimed "synthetic polymer"; distearyldimethylammonium and trioctylmethyl ammonium oniums are not reasonably commensurate with claimed type of intercalant modifier that includes any ammonium or phosphonium compound; bisphenol A diglycidyl ether is not reasonably commensurate with "compound selected from bisphenol A diglycidyl ether, bisphenol F diglycidyl ether, 1,2-cyclohexanedicarboxylate, and phenol novolak epoxy resin"; and the exemplified tris(2,4-di-tertbutylphenyl)phosphite and/or compound of claimed formula (Ic) is not reasonably commensurate with claimed phenolic antioxidant and/or processing stabilizer which includes 9 other antioxidants or stabilizers. Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1796

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

vn

/Vickey Nerangis/

Primary Examiner, Art Unit 1796